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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,898	07/30/2002	Tugrul T. Kararli	6794S-000005USC	8229

7590 05/24/2005

Harness Dickey & Pierce
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7700 Bonhomme
St Louis, MO 63105

EXAMINER

AZPURU, CARLOS A

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 05/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/031,898	Applicant(s) KARARLI ET AL	
	Examiner Carlos A. Azpuru	Art Unit 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,4-7,12-15 and 19-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2, 4-7, 12-15 and 19-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Receipt is acknowledged of the amendment and request for reconsideration filed 03/14/2005. The preliminary amendment of 07/30/2002 has been noted.

Information Disclosure Statement

Applicant's remarks concerning the IDS's which have not been initialed have been noted. However as explained in the prior action, the PTOL-1449's attached to the information disclosure statements are missing from the file. Applicant is again requested to provide a copy of these PTOL-1449's so that they can be initialed, since the references associated with them have been considered. These documents can not be initialed if applicant does not provide another copy.

The following rejections are maintained in this action:

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

Art Unit: 1615

patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 2, 4-7, 12-15, 19-31 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-58 of copending Application No. 09/874,504 (US'504). Although the conflicting claims are not identical, they are not patentably distinct from each other because US'504 claims an oral pharmaceutical of COX-2 inhibitors comprising a drug particle with a D90 particle size between 0.01 μm and 200 μm (see claim 1). The percentage of particles smaller than 1 μm is between 25% and 100% (see claim 2). There may also be 25% to 100 % of the particles with a size between 450 nm and 1000 nm (see claim 3). The structure of the compound of claim 15 is the same as that of claims 1 and 10 of the instant application. Substituted ring systems and the particular COX-2 inhibitors are listed at claims 16-18. The unit dosage is set out in claim 19. A method of analgesia, which is a method of treating a COX-2 disorder, are set out in claims 20-28, 46-54, 57 and 58. Therefore, those of ordinary skill would have expected similar therapeutic results from the instant composition and method of treating given the claims of US'504 which sets out a similar composition, and for the treatment of a well known Cox-2 related disorder such as pain. There are no unusual and/or unexpected results which would rebut prima facie obviousness. The instant claims would have therefore been obvious given the claims of US'504.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 2, 4-7, 12-15, 19-31 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-58 of copending Application No. 10/113,157 (US'157). Although the conflicting claims are not identical, they are not patentably distinct from each other because US'157 claims an oral pharmaceutical of COX-2 inhibitors comprising a drug particle with a D90 particle size between 0.01 um and 200 um (see claim 1). The percentage of particles smaller than 1 um is between 25% and 100% (see claim 2). There may also be 25% to 100 % of the particles with a size between 450 nm and 1000 nm (see claim 3). The structure of the compound of claim 15 is the same as that of claims 1 and 10 of the instant application. Substituted ring systems and the particular COX-2 inhibitors are listed at claims 16-18. The unit dosage is set out in claim 19. A method of analgesia, which is a method of treating a COX-2 disorder, are set out in claims 20-28, 46-54, 57 and 58. Therefore, those of ordinary skill would have expected similar therapeutic results from the instant composition and method of treating given the claims of US'504 which sets out a similar composition, and for the treatment of a well known Cox-2 related disorder such as pain. There are no unusual and/or unexpected results which would rebut prima facie obviousness. The instant claims would have therefore been obvious given the claims of US'157.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

Applicant's arguments filed 05/22/2005 have been fully considered but they are not persuasive.

Applicant argues that since the only rejection in the application are obviousness-type double patenting rejections, they should be dropped, and the case moved to issue. However, applicant is reminded that according to MPEP 804(I), this is the case only when an obviousness-type double patenting rejection is made in both cases, and the cases are linked in some way. If such was the case in these applications, the rejections would have indeed been dropped. However, review of these files indicates that obviousness-type double patenting have not been filed in either copending cases. As such, to overcome the rejections, applicant needs to file terminal disclaimers over both. No arguments were made as to the merits of the rejections in either case. As such, both rejections are maintained in this action.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

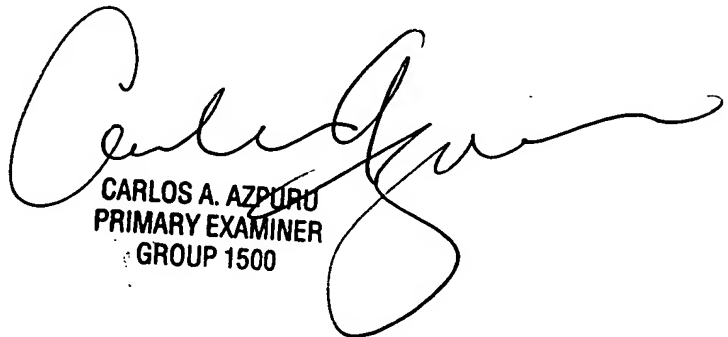
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carlos A. Azpuru whose telephone number is (571) 272-0588. The examiner can normally be reached on Tu-Fri, 6:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1615

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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